

REMARKS

Claims 1-4, 11, 12, 14 and 15 are all the claims pending in the application. Claim 15 was added by the Preliminary Amendment filed June 12, 2003.

In response to the RCE and Preliminary Amendment filed June 12, 2003, all of the claim rejections have been repeated, except that the rejection of claim 14 has been modified and an additional rejection of claim 14 has been included. Specifically, the previously-applied Friedman reference is no longer applied in the alternative with Applicant's admitted prior art in the first rejection of claim 14. Also, a second rejection of claim 14 has been added, which rejects the claim over the combination of previously-cited references Kato, Logan et al., Wood et al., Blomberg et al., Friedman, and Elias et al. The status of the claims is as follows:

Claims 2, 11, and 14 are objected to, because of typographical errors, which are corrected in the present Amendment.

Claims 1-4 and 11 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over previously-cited Kato (JP 09-99444) in view of previously-cited Logan et al. (US 4,711,035), in further view of previously-cited Wood et al. (US 5,053, 971), and in further view of either previously-cited Blomberg et al. (US 6,242,065) or the previously-cited Applicant's admitted prior art (AAPA).

Claim 12 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kato in view of Logan et al., in further view of Wood et al., in further view of either Blomberg et al. or AAPA, and further in view of previously-cited Komatsu et al. (JP 06-191159).

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Claim 14 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kato in view of Logan et al., in further view of Wood et al., in further view of AAPA, and in further view of previously-cited Elias et al. (US 4,915,986).

Also, claim 14 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kato in view of Logan et al., in further view of Wood et al., in further view of Blomberg et al., in further view of previously-cited Friedman (US 6,159,397), and in further view of Elias et al.

Claim 15 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Kato in view of Logan et al., in further view of Wood et al., and in further view of AAPA.

Applicant respectfully traverses the claim rejections with the following comments.

A spectacle lens is produced by the following process:

Molding → Processing lens such as polishing, dyeing, etc. → Edging

Generally, edging is conducted in a retail shop of a spectacle lens, because a retail shop of a spectacle lens has information about the size and shape of a lens opening in an eyeglass frame. The apparatuses for edging as described in Logan et al. and Wood et al. relate to this type of edging.

In recent years, however, because of the lack of the number of laborers skilled in works of edging and inserting the edged lenses in spectacle frames and employed in spectacle shops, there have been strong demands for lens makers to process lenses until edging and deliver the edged lenses to retail shops.

The edging process performed by lens makers is conducted with a computerized edging apparatus by receiving spectacle frame information. Thus, an edging mark is not depicted by lens makers. By contrast, an edging mark is depicted in retail shops of a spectacle lens.

Therefore, it would have been unexpected to one of ordinary skill in the art of eyeglass manufacturing to have an edging mark depicted during the part of the manufacturing process performed by lens makers.

Kato relates to a mold for a plastic multi-focus spectacle lens. In Kato, reference marks on a lens are transferred from mold at the same time of lens molding. Kato only discloses reference marks on a lens. Marking by transfer from mold is a common technology. As described in the specification of the present invention, “Two concealed marks 20 transferred from the mold at the above-described lens material polymerization step appear inconspicuously on a lens 10 shown in Fig.2(a).” Page 12, line 23 - page 13, line 2. Marking by transfer from mold is useful, because no further marking step is needed. However, since the marking is transferred from the mold, it is impossible to depict a mark without the mold. Therefore, Kato does not disclose or suggest a marking step after a step of forming the spectacle lens (molding) and before processing the lens, such as in a polishing step.

Moreover, none of the cited references teach or suggest a marking step after a step of forming the spectacle lens and before processing the lens such as by polishing.

Logan et al. teach that the optical industry generally produces a pattern having the size and shape of a lens opening in an eyeglass frame for use as a guide in an edge grinding and contouring apparatus to peripherally edge grind the optical lens to the size and shape of the lens opening. The shape of the lens opening is transferred to the surface of the lens blank by tracing the inner periphery of the lens opening with a marker. The blank is then cut following the outline on the blank surface to form a pattern corresponding to the associated traced lens opening (Col. 1, lines 15-30).

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Logan et al. teach only a general edging process in retail shops of a spectacle lens. The edging process is the last process of the lens manufacturing process, because in the edging process the optical lens is grinded to the size and shape of the lens opening after processing the lens, such as by polishing.

Therefore, Logan et al. teach that a marking by tracing the inner periphery of the lens opening with a marker is only used for cutting following the marking.

Wood et al. teach a method and apparatus for edging. Blomberg et al. teach general lens processing, such as a hard coat formation step.

Kato, Logan et al., Wood et al. and Blomberg et al. do not teach or suggest any motivation to create a marking step after a step of forming the spectacle lens and before processing the lens, such as by polishing.

Therefore, it would not have been obvious to construct the present invention by combination of Kato, Logan et al., Wood et al. and Blomberg et al.

Furthermore, the edging mark in the present invention exists in a second region to be cut off by the edging, so the edging mark of the present invention is not a cutting line. And the edging mark of the present invention is cut off by edging. The edging mark of the present invention, which is depicted by a marking step after a step of forming the spectacle lens and before processing the lens such as by polishing and is cut off by edging, has a function as a boundary for appearance inspection in the steps of processing lens such as a polishing step, a dyeing step, a hard coat formation step and an anti-reflection coating formation step. Kato, Logan et al., Wood et al. and Blomberg et al. do not disclose or suggest the idea of the edging mark having a function as a boundary for appearance inspection in the steps of processing lens

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such as polishing. Therefore, it is clear that the present invention would not have been obvious at the time the invention was made to a person having ordinary skill in the art of the subject matter to which the invention pertains, for this reasons as well.

Therefore, claims 1-4, 11, 12, 14 and 15 are allowable over the prior art.

With further regard to claim 15, Applicant submits that the prior art fails to teach or suggest an appearance inspection step of inspecting only the first region of the spectacle lens, wherein the appearance inspection step is performed prior to the edging step. The Examiner admits that the combination of references does not teach that only the first region of the spectacle lens is inspected during the appearance inspection step. To overcome this acknowledged deficiency in the prior art, the Examiner asserts that it would have been obvious to modify the teachings of the combination of references to inspect only the region of the lens blank that will become the finished lens during appearance inspection to guarantee the quality of the finished lens without spending unnecessary time and effort inspecting a portion of the lens blank that will be edged off. See Office Action, page 13, lines 16-21. However, it is the Applicant who first identified and provided a solution for this problem in the prior art, as disclosed in the present specification. In particular, the Applicant notes that in the conventional method of lens processing the appearance quality of the entire lens is guaranteed. See page 6, lines 16-17, of the present specification. The advantages of the Applicant's claimed method are described in the specification at page 27, line 3 - page 28, line 2, for example, including reduction in manpower and time for inspection and thus reduced lens production cost.

Although the Examiner asserts that the modification to the prior art would have been obvious, the Examiner has provided no support for this assertion. Rather, Applicant respectfully

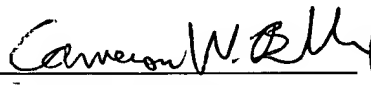
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submits that the Examiner is engaging in impermissible hindsight reconstruction, by using the Applicant's own disclosure against him to support the claim rejection. In particular, the Examiner states that there would be no reason for one of ordinary skill in art to inspect the portion of the lens blank that will be edged off and discarded (Office Action, page 14, lines 1-2), but as noted above, inspecting the entire lens is a problem in the conventional appearance inspection process for which the Applicant has provided a solution. Therefore, claim 15 is allowable over the prior art.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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